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EXAMINER

PAULA, C

ART UNIT

PAPER NUMBER

2776

DATE MAILED: 09/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/978,753

Applicant(s)

MARKOVIC ET AL.

Examiner

CESAR B PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-28, 30-35, 37-40, 42-45 is/are rejected.
- 7) ☒ Claim(s) 8-9, 29, 36, and 41 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. This action is responsive to the amendment filed on 6/23/2000.

This action is made non-final.

2. In the amendment, claim 1-45 are pending in the case. Claims 1, 23-24, 27, and 38-40 are independent claims.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Objections

4. Appropriate corrections were made to claim 10, therefore its objections have been withdrawn.

Claim Rejections - 35 USC § 112

5. Appropriate corrections were made to claim 45, therefore its 112 first and second paragraph rejections have been withdrawn.
6. Claims 1-4, 10-28, 30-31, 34, 38-40, and 42-45 remain, and 5-7, 32-33, 35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al (Pat. # 5,774,232, 6/30/1998, filed on 9/21/1995) in view of Miller et al (Pat. # 5,696,605, 12/9/1997, filed on 11/20/1992).

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Regarding independent claim 1, Tabata et al disclose: "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach: *receiving in a computer a first electronic document*. However, Miller et al disclose: "...U/I 52 interfaces....enabling the operator to program print jobs and other instructions.....Main memory 56 has plural hard disks....for storingscanned image data....." (Col. 4, lines 11-32). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that this storage of information would have allowed the operator to process the stored document.

Moreover, Tabata et al disclose: "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach: *receiving in the computer a user input that selects an instruction for assembling a hard copy document*. However, Miller et al disclose: "...U/I 52 interfaces....enabling the operator to program print jobs and other instructions.....Main memory 56 has plural hard disks....for storingscanned image data....." (Col. 4, lines 11-32). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that this storage of information would have allowed the operator to process the stored document.

Moreover, Tabata et al disclose: *determining in the computer a visual appearance.....--*
"...When the staple function is selected, the control section 2108 displays a staple position input

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screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the display of the appearance of a document as if it was printed, and bound with a staple.

Furthermore, Tabata et al disclose: *producing as output the determined visual appearance*--“....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, printing the selected settings for the binding of the document.

Regarding claim 2, which depends on claim 1, Tabata et al disclose: *generating a second electronic document which depicts the first electronic document*.....-- “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the display of the appearance of a document as if it was printed-- *a second electronic document which depicts the first electronic document*--, and bound with a staple.

Furthermore, Tabata et al disclose: *displaying the second electronic document*-- “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the display of the appearance of a document as if it was printed, and bound with a staple.

Regarding claim 3, which depends on claim 2, Tabata et al disclose: *receiving a second user input that selects a second instruction*.....-- “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the selection from a menu of options to instruct the system to display of the appearance of a document as if it was printed-- *a second user input*--, and bind it with a staple.

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Regarding claim 4, which depends on claim 2, Tabata et al disclose: *modifying a copy of the first electronic document to generate the second electronic document*-- “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the selection from a menu of options to instruct the system to display of the appearance of a document as if it was printed, and bind it with a staple-- *modifying a copy of the first electronic document to generate the second electronic document*.

Regarding claim 5, which depends on claim 4, Tabata et al disclose: *...modifying the copy of the first electronic document includes adding a tile depicting a change in the visual appearance*.....--“....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, a tile to add, and display the visual appearance of a document as if it was printed, and bound with a staple.

Regarding claim 6, which depends on claim 5, Tabata et al disclose: *...retrieving the tile from a database*.....--“....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65, Fig. 20a). Tabata et al teach in the previous quote, a tile, from memory-database-- to add, and display the visual appearance of a document as if it was printed, and bound with a staple.

Regarding claim 7, which depends on claim 6, Tabata et al disclose: *...the database includes an entry for each instruction*.....--“....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65, Fig. 20a). Tabata et al teach in the previous quote, the selection of a tile from a several tiles on a screen, and

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retrieving the tiles from memory-database-- to add, and display the visual appearance of a document as if it was printed, and bound with a staple.

Regarding claim 10, which depends on claim 8, Tabata et al disclose:-- "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach:*modifying a copy of the first electronic document inserting a page into copy* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to had performed this step, because Tabata et al teach above, the sorting of the document in the order selected by the user, and the insertion of a page to be copied into the system for performing image processing.

Regarding claim 11, which depends on claim 10, Tabata et al disclose: "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach:*the inserted page is a cover sheet*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to had performed this step, because Tabata et al teach above, the sorting of the document in the order selected by the user or inserting -- *a cover sheet*.

Regarding claim 12, which depends on claim 1, Tabata et al disclose: "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach: *user input is received from an electronic file*. However, Miller et al disclose: "...U/I 52 interfaces....enabling the operator to program print

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jobs and other instructions.....items displayed on touchscreen 62 such as files.....” (Col. 4, lines 11-32). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that this storage of information would have allowed the operator to process the stored document.

Regarding claim 13, which depends on claim 1, Tabata et al disclose: “...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6, lines 18-34). Tabata et al fail to teach: *The instruction identifies a printing media to be used....* However, Miller et al disclose: “...the print media may comprise of any variety of sheet sizes.....” (Col. 3, lines 10-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that this would have allowed the operator to select from a wide variety of printing media.

Regarding claim 14, which depends on claim 13, Tabata et al disclose: “...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6, lines 18-34). Tabata et al fail to teach: *the instruction identifies the weight, color, texture.....* However, Miller et al disclose: : “...the print media may comprise of any variety of sheet sizes.....” (Col. 3, lines 10-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al,

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because Miller et al teach above, that this would have allowed the operator to select from a wide variety of printing media.

Regarding claim 15, which depends on claim 13, Tabata et al disclose: “....image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6, lines 18-34). Tabata et al fail to teach: *the instruction identifies a pre-existing image*..... However, Miller et al disclose: : “....the print media may comprise of any variety of sheet sizes.....” (Col. 3, lines 10-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that this would have allowed the operator to select from a wide variety of printing media.

Regarding claim 16, which depends on claim 1, Tabata et al disclose: “....image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6, lines 18-34). Tabata et al fail to teach:*the instruction identifies a cover to be used*..... However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to had performed this step, because Tabata et al teach above, the sorting of the document in the order selected by the user-- *the instruction identifies a cover to be used*.

Regarding claim 17, which depends on claim 1, Tabata et al disclose:*the instruction identifies a binding to be used*.....-- “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the

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previous quote, the selection from a menu of options to instruct the system to display of the appearance of a document as if it was printed, and bind it with a staple.

Regarding claim 18, which depends on claim 17, Tabata et al disclose: "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach:*the instruction identifies a veloTM, tape, spiral....* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to had performed this step, because Tabata et al teach above, the sorting of the document in the order selected by the user and then binding the document.

Regarding claim 19, which depends on claim 1, Tabata et al disclose:*the instruction identifies a physical modification of a printing media.*-- "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al teach above, the sorting of the document in the order selected by the user and then binding the document-- *physical modification*.

Regarding claim 20, which depends on claim 19, Tabata et al disclose: "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach:*the instruction identifies a physical modification of a printing media.* However, Miller et al disclose: "...signature set stitcher 10a, signature set folder 10b, and signature set trimmer 10c....." (Col. 3, lines 40-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings

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of Tabata et al and Miller et al, because Miller et al teach above, that these devices enabled the system to produce a finished document.

Regarding claim 21, which depends on claim 1, Tabata et al disclose: *...the user input is received through an interactive user interface--* “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the selection from a menu of options-- *an interactive user interface--* to instruct the system to display of the appearance of a document as if it was printed, and bind it with a staple.

Regarding claim 22, which depends on claim 21, Tabata et al disclose: *...receiving the user input includes displaying a plurality of instruction identifiers.....--* “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the selection from a menu of options-- *instruction identifiers--* to instruct the system to display of the appearance of a document as if it was printed, and bind it with a staple.

Claim 23 is directed towards a method for displaying a finished hard copy document for implementing the steps found in claim1, and is similarly rejected.

Claim 24 is directed towards a computer-assisted method for creating a hard copy document for implementing the steps found in claim1, and is similarly rejected.

Regarding claim 25, which depends on claim 24, Tabata et al disclose: *...the document assembler prints the electronic document.....--* “....When the staple function is selected, the control section 2108 displays a staple position input screen.....the user touches ‘Execute’ on the screen, the selected staple position is transferred to the control section.....” (Col. 20, lines 57-

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65, and Fig. 20A-20E). Tabata et al teach in the previous quote, the printing, and binding with a staple of a document.

Regarding claim 26, which depends on claim 24, Tabata et al disclose: *...creating a second electronic document which depicts the visual appearance of the hard copy document.....*--“....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65). Tabata et al teach in the previous quote, the display of the appearance of a document as if it was printed, and bound with a staple.

Claim 27 is directed towards a computer program for implementing the steps found in claim1, and is similarly rejected.

Regarding claim 28, which depends on claim 5, Tabata et al disclose: “....image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6, lines 18-34). Tabata et al fail to teach: *the computer receives user input that selects a plurality of instructions*. However, Miller et al disclose: “....U/I 52 interfaces....enabling the operator to program print jobs and other instructions.....Main memory 56 has plural hard disks....for storingscanned image data.....” (Col. 4, lines 11-32). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that this storage of information would have allowed the operator to process the stored document.

Regarding claim 30, which depends on claim 20, Tabata et al disclose: “....image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6,

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lines 18-34). Tabata et al fail to teach:*the instruction identifies cutting of the printing media*. However, Miller et al disclose: “....signature set stitcher 10a, signature set folder 10b, and signature set trimmer 10c.....” (Col. 3, lines 40-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that these devices enabled the system to produce a finished document.

Regarding claim 31, which depends on claim 20, Tabata et al disclose: “....image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6, lines 18-34). Tabata et al fail to teach:*the instruction identifies folding of the printing media*. However, Miller et al disclose: “....signature set stitcher 10a, signature set folder 10b, and signature set trimmer 10c.....” (Col. 3, lines 40-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that these devices enabled the system to produce a finished document.

Regarding claim 32, which depends on claim 5, Tabata et al disclose: ...*the instruction identifies the size of the tile*--“....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65, Fig. 20a), and --“....it is assumed herein that a sheet ...having size B4 is shown.....” (Col. 17, lines 44-67). Tabata et al teach in the previous quote, specifying the size of the paper used for printing a document.

Regarding claim 33, which depends on claim 5, Tabata et al disclose: ...*the instruction identifies the position of the tile*--“....When the staple function is selected, the control section

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2108 displays a staple position input screen.....” (Col. 20, lines 57-65, Fig. 20a), and -“....it is assumed herein that a sheet ...having size B4 is shown.....” (Col. 17, lines 44-67). Tabata et al teach in the previous quote, specifying the position of the tile used for printing a document.

Regarding claim 34, which depends on claim 4, Tabata et al disclose:*extracting information from the first electronic document*-- “....A first image....is formed as described abovewhich sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book.....” (Col. 6, lines 18-34). Tabata et al teach in the previous quote, the extraction of image information to be printed.

Regarding claim 35, which depends on claim 5, Tabata et al disclose: ...*adding a tile*.....-- “....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65, Fig. 20a), and -“....it is assumed herein that a sheet ...having size B4 is shown.....” (Col. 17, lines 44-67). Tabata et al teach in the previous quote, specifying the visual appearance of a document to be printed.

Regarding claim 37, which depends on claim 5, Tabata et al disclose: ...*the instruction identifies a binding option*...--“....When the staple function is selected, the control section 2108 displays a staple position input screen.....” (Col. 20, lines 57-65, Fig. 20a), and -“....it is assumed herein that a sheet ...having size B4 is shown.....” (Col. 17, lines 44-67). Tabata et al teach in the previous quote, specifying the position of a binding used for printing a document.

Claim 38 is directed towards a method of depicting a hard copy document for implementing the steps found in claim 1, and is similarly rejected.

Claim 39 is directed towards a method of depicting a hard copy document for implementing the steps found in claim 1, and is similarly rejected.

Claim 40 is directed towards a method of depicting a hard copy document for implementing the steps found in claim 1, and is similarly rejected.

Regarding claim 42, which depends on claim 1, Tabata et al disclose: "...image recording apparatus.....which sorts recording paper with image data recorded thereon with a sorter and binds a bundle of the sorted recording paper with a stapler into a book....." (Col. 6, lines 18-34). Tabata et al fail to teach: *producing the determined visual appearance as output includes displaying the determined visual appearance on a computer monitor*. However, Miller et al disclose: "...U/I 52 interfaces....enabling the operator to program print jobs and other instructions.....Main memory 56 has plural hard disks....for storingscanned image data....." (Col. 4, lines 11-32). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Tabata et al and Miller et al, because Miller et al teach above, that this storage of information would have allowed the operator to process the stored document.

Regarding claim 43, which depends on claim 1, Tabata et al disclose:*determining the visual appearance includes obscuring a portion of the output*--"...When the staple function is selected, the control section 2108 displays a staple position input screen....." (Col. 20, lines 57-65, and Fig. 20A-20E). Tabata et al teach in the previous quote, the display of the obscured appearance of a document as if it was printed, and bound with a staple.

Claim 44 is directed towards a method for implementing the steps found in claim 1, and is similarly rejected.

Regarding claim 45, which depends on claim 1, Tabata et al disclose:*determining the visual appearance includes providing an of the thickness*--"...automatic change mode

shown in Fig. 13 (b), a binding space width of recording paper becomes gradually larger.....”
(Col. 21, lines 40-67). Tabata et al teach in the previous quote, the display of the a binding width
of the appearance of a document before it was printed, and bound with a staple.

Allowable Subject Matter

7. Claims 8-9, 29, 36, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 6/23/2000 have been fully considered but they are not persuasive.

The Applicants indicate that: “....Tabata does not actually determine and then display the visual appearance...” (p. 2, pgph. 6). The Examiner disagrees with this statement, because Tabata teaches the selection by a user of a visual appearance(binding, etc) a document would take once printed, and determining in the computer how to bring about this visual appearance to the document, and printing it.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached on (703) 305-4713. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office
Washington, D.C. 20231

Or faxed to:

- (703) 308-9051, (for formal communications intended for entry)


Or:

- (703) 308-5403, (for informal or draft communications for discussion only, please label "**PROPOSED**" or "**DRAFT**").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

cbp

09/22/00


STEPHEN S. HONG
PRIMARY EXAMINER